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10/737,217

12/15/2003

Carl Young

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07/28/2006

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EXAMINER

WEBB, JAMISUE A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/737,217 | Applicant(s) YOUNG ET AL. | |
| | Examiner Jamisue A. Webb | Art Unit 3629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10,15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10,15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, 2, 4-10, 15 and 16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. An invention, which is eligible for patenting under 35 U.S.C. § 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “useful, concrete and tangible result.” The test for practical application as applied by the examiner involves the determination of the following factors:

- (a) “Useful” - The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. If the utility is not asserted in the written description, then it must be well established.

(b) “Tangible” - Applying *In re Warmerdan*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. § 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) “Concrete” - Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

4. Claims 1, 2, 4-10, 15 and 16 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. Specifically:

5. In Claims 1, 2, 4-10, 15 and 16, the ambiguities cited would make it impossible for the process to be repeatable or “concrete.” In other words, different users would come up with different responses.

6. As per Claims 1, 2, 4-10, 15 and 16, it appears that the method/system/program code is attempting to take in information from a news feed or a government agency, and relate security risks to an element based on the hierarchical relationship of elements. The specification lacks a description on how the information from the news feed or government agency is manipulated and related to the security risk. What criteria are used to determine if it is a security risk and if

Art Unit: 3629

the security risk is to a particular resource in a facility. Therefore without any teaching of how the data is taken in and the steps taken to relate them to elements (what does the computer do to the data to relate them to the selected elements), then the information input and the results generated in terms of the security risks, are subjective to the user, and if the user perceives it to be a threat. Therefore the method/system/program code is not repeatable, based on subjective information and would appear to be an attempt to patent an abstract idea not a “concrete” process. Furthermore the dependent claims relate the harm using a “subjective quantifier”. Which clearly states the harm is subjective, and does not produce a tangible/repeatable/concrete result.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1, 2, 4-10, 15 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims recite a “computer-implemented” method, which receives information from a government agency or news feed. The specification is silent as to how the computer takes in this information, and what steps are used to relate this information to security risks of hierarchical elements. The specification is silent as to how the data is being manipulated to relate the live data to security

Art Unit: 3629

risk. Therefore subjective to the user, and therefore one of ordinary skill in the art would not be able to proactive the invention without undue experimentation.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 4 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 4 recites the limitation "the element selected" in line 2. There is insufficient antecedent basis for this limitation in the claim. It is unclear if this is the first element or the second element.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beverina et al. (US 2001/0027388) in view of Zimmers et al. (US 2005/0013417).

14. With respect to Claims 1, 15, 16: Beverina discloses the use of a computer system with a computer implemented method for managing security risks (see abstract) which uses a computer executable code (paragraph 0011) to perform the following steps:

- a. Setting a hierarchical relationship between two or more elements where the first element is a facility and the second element is a resource located within the facility (See Figures 8 and 15, paragraphs 0015, 0078, 0079 and 0110),
 - b. Receiving an indication of a security risk of one or more of the elements (See Figures 8 and 15, paragraph 0011),
 - c. Receiving selection of a first element and a second element (See Figure 15, Beverina teaches the Risk assessment to Ft. Belvoir, and to a building at Ft. Belvoir, which has a hierarchical relationship); and
 - d. Transmitting a description of the security risk as it relates to the element selected based on hierarchical relationship and indication of security risk (See Figures 15 and 16, paragraph 0012);
 - e. Allowing a user to traverse between the hierarchical elements (Figure 23, discloses user allowing to determine Building Damage, second element, as well as geographic effects, which is considered to be more a facility or first element.)
15. Beverina however, discloses the security risks are situational risks, fails to disclose the information related to the security risk is in real-time and is from a government agency or a news feed. Zimmers discloses the use of a real time weather feed, which the examiner considers to be a type of news feed, that is fed into a system and element information related to the risk are gathered and outputted based on facilities (See abstract, and Figure 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Beverina, to include the informational information/news feed of Zimmers, in order to provide emergency information to persons needing to be notified of such information, and individuals

Art Unit: 3629

can be notified of emergency that directly threatens or of interest to him or her. (See Zimmers, pages 1 and 2)

16. With respect to Claim 2: See Beverina Figure 16 and paragraph 0106.

17. With respect to Claim 4: See Beverina Figures 15, 16, 23 and 24.

18. With respect to Claim 5: the limitation of the security risk comprising misappropriation of information is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The steps of transmitting security risks would be performed the same regardless of what type of threat the security risk is based on. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

19. With respect to Claim 6: See Beverina Figure 23, paragraphs 0013 and 0096.

20. With respect to Claim 7: See Beverina paragraphs 0174, 0175 and 0209-0222.

21. With respect to Claim 8: See Beverina Figures 21 and 40, paragraph 0085.

22. With respect to Claim 9: See Beverina Figures 15 and 19.

23. With respect to Claim 10: See Beverina Paragraph 0198.

Response to Arguments

24. Applicant's arguments filed 5/11/06 have been fully considered but they are not persuasive.

25. With respect to Applicant's arguments that Beverina does not disclose setting a hierarchical relationship between elements: The applicant has stated that the office action admits

Art Unit: 3629

that Beverina does not disclose setting a hierarchical relationship. The office action however states that where as Beverina does not specifically state that it sets a hierarchical relationship, it inherently sets one. Even if Beverina fails to calls them hierarchical, does not mean that Beverina does not teach the use of them. Beverina discloses a Building, where in the system the user sets floors of the building, therefore setting a hierarchical relationship. And discloses setting buildings within a city, therefore Beverina inherently sets a building/city hierarchical relationship between the building and a city. Even though the relationships are necessary, does not mean the relationships are not inherent. The examiner invites the applicant to point out in the specification, where the "setting of hierarchical" has steps which cause the hierarchical relationship to be more than the floor/building relationship of Beverina.

26. The applicant is basing the arguments on the fact that Beverina does not set hierarchical relationship, the examiner feels Beverina does this, therefore rejections stand as stated above.

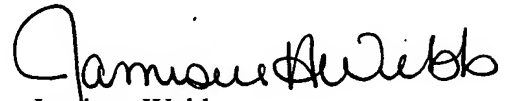
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jamisue Webb
Patent Examiner
Art Unit 3629